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Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/418,744 10/15/99 WEIBEL

W EISA-101

TM02/1102

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EXAMINER

GORT.E

ART UNIT

PAPER NUMBER

2167

DATE MAILED:

11/02/01 7

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/418,744

Applicant(s)

WEIBEL ET AL.

Examiner

Elaine Gort

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al. (US Patent 6,173,217) in view of Bednar (EP 0745947).

Goodman et al. discloses a method for constructing a billing statement which includes the use of a customer id (such as advertiser account number); digital invoicing (via billing computer) with cross reference of the ad to a digital publication page (video information indicating the advertisement and stripped information); an ad database containing digital ads with ad ids (digital storage of the ads where the ads have the ADTAG including booking information); a publication page database (billing information, stripped information); and where the billing computer searches the publication and ad database and creates an invoice cross referencing the ad and publication page.

Goodman et al. discloses the claimed device but remains silent regarding including the digital images of the ad documents and publication pages in the invoice and storing in a common file in an invoice database; and listing each invoice item as a

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line item; displaying the "documents" in human readable form. Bednar discloses that it is known in the art to create a digital invoice (figure 4) by copying and storing related digital images in a common file maintained in an invoice database (database containing files of completed invoices) for a specific time period; listing invoiced items as line items; and displaying the documents in human readable form to automatically combine digital billing invoice items into an invoice. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of constructing a billing statement of Goodman et al. with the digital image invoicing of Bednar, in order to automatically combine billing of digital invoice items and create an invoice for these items.

It is old and well known in the art of database storage to copy digital documents to a removable storage medium in order to back up the data files in the case of their loss. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the method of constructing a billing statement of Goodman et al. and Bednar as modified above with the step of copying to a removable storage medium in order to back up the files.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the official notice that publication pages have been historically included in publication invoices to allow the company placing the ad and paying the bill to verify the ad was run in the manner requested and billed. Customer ads would be stored in a file with identification associating the ad with the customer. Published material would be stored

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with page information and identification and ad identification. Copies of customer invoices would be filed for a history and billing reference. Providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish the claimed invention over the prior art in terms of patentability. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 93, 94 (CCPA 1958).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. See above for details and clarification.

Examiner would like to note that the Applicant's arguments relate to the references not showing print publication images when the claims do not positively recite print publication images.

Examiner would also like to point out that providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish the claimed invention over the prior art in terms of patentability. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 93, 94 (CCPA 1958). Publication pages historically have been included with ad invoices to show the company paying for the ad to be run to verify the ad was indeed published and published in the manner desired and billed for. It is not sufficient for patentability purposes to merely automate an old existing practice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-3597.

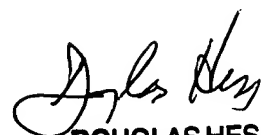
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG



October 31, 2001



DOUGLAS HESS
PRIMARY EXAMINER

11-2-01